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been assigned to Johnson by Field in partial settlement of its claims.

Order for Judgment

The Clerk shall enter judgment forthwith on these Findings and Conclusions as follows:

1. Copyright Registration No. A 914,583, the registration of a claim to copyright for the original 3-D chess rule book, is valid and infringed.

2. Copyright Registration No. A 242,609, the registration of a claim to copyright for the revised 3-D chess rule book, is valid and infringed.

3. Copyright Registration No. Gp 72,347, the registration of a claim to copyright for the 3-D chess sculpture, is valid and infringed.

4. The counter-claims of Salomon against Johnson are dismissed with prejudice.

5. Defendant and his respective agents, servants, employees, and all persons in active concert or participation with him who will receive actual notice of this judgment by personal service or otherwise be and are hereby permanently restrained and enjoined, pending further order, throughout the unexpired term of said copyrights and any renewals or other extensions thereof, from directly or indirectly infringing said copyrights by the printing, reprinting, publishing, copying, or vending in the United States and the world any book, sculpture, or other material embodying the material protected in and by said copyrights or by advertising, offering for sale, or otherwise commercializing any such book or other material or from inducing, aiding, abetting, or in any way contributing to the infringement of said copyrights.

6. Plaintiff, Lynn R. Johnson, is hereby granted Judgment against defendant Herbert Salomon on Counts I, II, and III of Plaintiff's Complaint on the basis that Salomon deliberately, willfully, and purposefully infringed and contributorily infringed the three copyrights with full knowledge thereof.

7. Plaintiff is therefore entitled to and is hereby awarded the following recovery:

- a) \$1,000, for profits of defendant as established by plaintiff;
- b) \$5,000, for in lieu of actual damages under 17 USC Section 101(b) for the willful and purposeful infringement of Copyright Registration No. A 914,583;
- c) \$5,000, for in lieu of actual damages under 17 USC Section 101(b) for the willful and purposeful infringement of Copyright Registration No. A 242,609;

d) \$5,000, for in lieu of actual damages under 17 USC Section 101(b) for the willful and purposeful infringement of Copyright Registration Gp 72,347;

e) \$5,000, for damages arising from the unfair competition of defendant Salomon and punitive and exemplary damages due to the willful, purposeful, and knowing infringement of defendant Salomon and due to the active, willful, and knowingly fraudulent misrepresentations made to the other infringers and also to plaintiff, including the concealment of the infringing activities of Salomon and the other infringers from plaintiff;

f) Costs, as allowed under 17 USC Section 116; and

g) \$15,000, as reasonable attorney fees under 17 U.S.C. Section 116.

8. Field Manufacturing Co., Inc. is hereby granted Judgment against defendant, Herbert Salomon, on Counts I and II of the Field crossclaim. Since Field, as a part of the settlement with plaintiff, assigned to plaintiff its rights on the crossclaim, plaintiff, Lynn R. Johnson, is hereby granted this Judgment of Field.

9. Plaintiff, Lynn R. Johnson, is further and independently granted Judgment against defendant, Herbert Salomon, as a joint tortfeasor with Field Manufacturing Co., Inc. for knowingly and purposefully causing, participating, and furthering the infringement of the three copyrights in suit by Field.

Patent and Trademark Office Board of Patent Interferences

McLaughlin

v. Roberts, Liebowitz, and Furgal

Decided Jan. 10, 1978

PATENTS

1. Interference — Interference in fact (§41.40)

Interference — Issues determined (§41.45)

Question of no interference in fact is one that may be considered by Board of Patent Interferences at final hearing.

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2. Interference — Interference in fact (§41.40)

Primary question to be decided when contention of no interference in fact is raised is whether parties are claiming same invention.

3. Specification — Sufficiency of disclosure (§62.7)

Description requirement of 35 U.S.C. 112 is satisfied in case in which one of ordinary skill in art, given applicant's disclosure, would consider that use of 10 to 25% range in recitation in one claim would be part of invention, even though that upper limit is not specifically disclosed, under test enunciated in *In re Wertheim*, 191 USPQ 90.

4. Specification — Sufficiency of disclosure (§62.7)

Fact that 10 to 25% was not disclosed as preferred part of range or that there are no examples of percentages within lower range is not persuasive that one of ordinary skill in art would not be able to practice invention using compositions having component content within that range.

5. Interference — Diligence — In general (§41.251)

Interference — Practice (§41.60)

Pleading and practice in Patent Office — Rules effect (§54.9)

Junior party who desires to raise issue of diligence must do so in his main brief, in view of requirement of Patent Rule 254 that "(t)he brief for the junior party shall present a full, fair statement of the questions involved," and as matter of fundamental fairness; use of question of diligence that is not in main brief, but in reply brief, "transgresses against the canons of fair forensics."

6. Interference — Evidence — Corroboration (§41.355)

Testimony, as to composition of solution, of one to whom it was merely hearsay, and based upon what inventor told him, is not effective corroboration.

7. Interference — Evidence — Corroboration (§41.355)

Interference — Evidence — Reduction to practice (§41.361)

Reduction to practice of counts that are not specific to any particular foam composition, but merely recite foam "containing said adjuvant material," can be corroborated by testimony of witnesses who used foam of unknown composition and observed that it had adjuvant effect on clothes being dried.

8. Interference — Evidence — Corroboration (§41.355)

Interference — Evidence — Reduction to practice (§41.361)

Subsequent use of product cannot corroborate actual reduction to practice of counts that specify particular ranges for its various components.

9. Interference — Priority (§41.70)

Facts that patentee's period of delay between reduction to practice and application filing was two and one-half years, and that assignee of party charged with delay was not major corporation are sufficient to avoid charge of prima facie unreasonable delay, especially in interference in which there is some evidence that inventor was continuing work on invention subsequent to his actual reduction to practice.

Particular patents — Fabric Conditioning

3,796,599, McLaughlin, Method of Treating Clothes in a Clothes Dryer with a Foam Containing an Adjuvant Material, awarded priority as to claims 1-3, and denied priority as to claims 4-6, against Roberts, Liebowitz, and Furgal application.

Patent interference No. 98,815 between James Hugh McLaughlin, Patent No. 3,796,599, issued Mar. 12, 1974, on application, Serial No. 164,917, filed July 21, 1971, and Karl H. Roberts, Marvin Liebowitz, and Henry P. Furgal, application, Serial No. 441,303, filed Feb. 11, 1974, accorded benefit of application, Serial No. 109,691, filed Jan. 25, 1971. Priority awarded to party McLaughlin in part, and party Roberts in part.

Harvey Mortimer, Morris Relson, Gordon D. Coplein, William F. Dudine, Jr., Michael J. Sweedler, David R. Francescani, and Darby & Darby, all of New York, N.Y., for party McLaughlin.

Herbert S. Sylvester, Murray M. Grill, Norman Blumenkopf, Ronald S. Cornell, Thomas J. Corum, Richard N. Miller, Robert L. Stone, and Raymond F. Kramer, all of New York, N.Y., John J. Tomaszewski, Rockville Center, N.Y., and Ellsworth H. Mosher, Arlington, Va., for party Roberts.

Before Calvert, and Torchin, Examiners of Interferences, and Sofocleous, Acting Examiner of Interferences.

Calvert, Examiner of Interferences.

This interference concerns the treatment of clothes with an adjuvant, such as a fabric

softener, in which the adjuvant is applied to the wet clothes before drying them in a clothes dryer. The particular invention resides in the fact that the adjuvant is contained in a foam.

The issue consists of six counts, corresponding exactly to claims 1 to 4, 6 and 7 of the McLaughlin patent, which is assigned to the Center for New Product Development, Inc. (CNPD). The counts are in two groups, counts 1 to 3 being broadly drawn to the method, and counts 4 to 6 reciting a more specific method in which the quantities of the ingredients of the foam are defined. Independent counts 1 and 4 are representative of the two groups:

Count 1

A method of treating clothing articles with an adjuvant material which comprises contacting at least a portion of said clothing articles with an easily distributable foam containing said adjuvant material, said foam being surface adherent for at least about thirty seconds, and subjecting said foam-contacted clothing to a tumbling, dry-heat, anhydrous environment.

Count 4

A method of treating clothing articles in a clothes dryer with an adjuvant material which comprises the steps of (A) contacting at least a portion of said clothing articles with a stable, substantially form-sustaining, substantially non-penetrating, surface adherent, and easily distributable foam, said foam comprising, by weight of the total composition, (a) from about 1.0 to 30.0 percent of said adjuvant material, (b) from about 50.0 to 94.0 percent of a solubilizer, (c) from about 5.0 to 25.0 percent of a propellant, and (d) from 0 to 30.0 of a foaming agent, and (B) subjecting said clothing articles to a tumbling action in a dry heat, substantially anhydrous environment.

Roberts et al. (Roberts), the senior party-applicants, copied counts 1 to 3 exactly, and counts 4 to 6 in modified form, pursuant to 37 CFR 1.205(a) and MPEP §1101.02, part A ("APPLICATION DISCLOSURE NARROWER THAN PATENT CLAIM"). The claims of the Roberts application which correspond to the counts are 21, 22, 23, 30, 31 and 33, respectively. The Roberts application is assigned to the Colgate-Palmolive Company.

Pursuant to stipulation under 37 CFR 1.272(c), each party filed an evidentiary record in the form of affidavits (McLaughlin) or stipulated testimony

(Roberts), accompanied by the relevant exhibits. Both filed briefs under 37 CFR 1.254, and appeared through counsel at final hearing.

During the motion period, McLaughlin filed a motion under 37 CFR 1.231(a)(1) to dismiss [sic:dissolve] counts 4, 5 and 6 which, in view of the arguments therein, was transmitted to the Primary Examiner by the Patent Interference Examiner as a motion to dissolve on the grounds of "(i) no interference in fact and (ii) lack of support in the disclosure of Roberts et al. for Roberts et al. claims 30, 31 and 33." (Paper No. 28, June 23, 1975). The Primary Examiner having denied the motion (Paper No. 30, September 4, 1975), McLaughlin seeks review of those grounds at final hearing.

No Interference In Fact

[1] The question of no interference in fact is one which may be considered by this Board at final hearing. *Nitz v. Ehrenreich*, 537 F.2d 539, 190 USPQ 413 (CCPA 1976). In order to resolve the question, the manner in which the claims of the patent were modified by the party copying them must first be considered. In the present case, Roberts modified McLaughlin's claims 4, 6 and 7 essentially by substituting narrower ranges for the ranges of the four components of the foam recited in claim 4. A helpful comparison of these ranges is set forth on page 19 of McLaughlin's main brief in tabular form:

	McLaughlin [claim 4]	Roberts et al [claim 30]
adjuvant	from about 1.0 to 30.0	from about 1.0 to 15.0
solubilizer	from about 50.0 to 94.0	about 50.0
propellant	from about 5.0 to 25.0	from about 10.0 to 25.0
foaming agent	from 0 to 30.0	from 0.5 to 15

McLaughlin's first contention is that the change of the lower limit of the range of foaming agent from zero to 0.5 constituted the omission of a material limitation or variation, because, with the zero lower limit, the claim includes a three-component system, but with a lower limit of 0.5 it can cover only a four-component system. This reduction in coverage from either three-component or four-component to four-component only constitutes the omission of a "highly material variation," in McLaughlin's opinion.

[2] While this argument would appear to be plausible on its face, we consider it to be without substance. The primary question to

be decided when a contention of no interference in fact is raised is whether the parties are claiming the same invention, *McCabe v. Cramblet*, 65 F.2d 459, 18 USPQ 71 (CCPA 1933), and in our view the parties in the present case are doing so.

Setting aside the question of whether a foam may be formed in the absence of a foaming agent, it is evident from the disclosure of the McLaughlin patent that the use of a foam composition in which no foaming agent is present is not in fact contemplated. What is contemplated is that if the adjuvant is *also* a foaming agent, a separate foaming agent need not be employed; thus at column 4, lines 24 to 29 of the patent McLaughlin discloses:

The nature of the foam formed is the consequence of many factors, *the foaming nature of the adjuvant, or of the foam inducing additive (if the adjuvant is of the type which does not foam of itself)*, and the critical proportions of the ingredients employed, including solubilizers, propellants, and the like. (Emphasis added)

It is also of interest to note that in column 3, lines 29 to 31, the patentee discloses that the amount of adjuvant can be reduced if foaming agents are added.

Turning to the specification of the Roberts application, we find the following disclosed on page 13:

As a rule, to produce the best products, one utilizes a conditioning agent for softening and/or antistatic effects and a different foaming agent to produce a desired physical form of the product. However, this is not necessary and *it is within the invention to utilize one material for both functions*. For example, triethanolamine stearate possesses both foaming and conditioning properties and a composition in which it is present with water and propellant possesses conditioning properties and is in satisfactory foam form. *Of course, if a single compound is to function as both conditioner and foaming agent, the amount utilized will usually be the sum of the amounts of separate components that would otherwise be employed*. (Emphasis added)

It is therefore apparent that if one adopts McLaughlin's definitions of "adjuvant" and "foaming agent," Roberts also discloses a three-component system; however, Roberts has chosen to define his composition as including at least 0.5 per cent foaming agent even though that foaming agent may also be an adjuvant. In other words, McLaughlin's contention of no interference in fact has arisen merely because the parties have

defined "adjuvant" and "foaming agent" somewhat differently, rather than because of any fundamental difference in their claimed inventions.

McLaughlin also asserts that there is no interference in fact because the maximum percentages of Roberts' four components total 105%, and since the amount of solubilizer is defined by Roberts claim 30 as "about 50.0 percent," the minimum amount of foaming agent would have to be 10%. This according to McLaughlin is further evidence of Roberts' lack of appreciation of the zero lower limit of foaming agent and that up to 94.0% of solubilizer can be used.

To the extent that the argument concerning the zero lower limit has not been treated above, we note, as did the Primary Examiner, that the term "comprising" as used in the counts admits of the inclusion of other, unrecited components, and therefore McLaughlin's conclusion that at least 10% foaming agent must be used does not follow. As to the narrowing of the range of solubilizer to about 50.0 percent, McLaughlin does not indicate how the use of a large proportion of solubilizer would be patentable over 50%, and since McLaughlin claims a range which includes 50%, he cannot reasonably assert that he and Roberts are claiming different inventions.

Insufficiency of Disclosure

The contentions of McLaughlin under this heading (pp. 23 and 24 of main brief) will be treated seriatim.

1. McLaughlin asserts that Roberts' recitation of about 50.0 percent solubilizer is not supported because his application contains no examples in which the amount of solubilizer (water) is greater than 42.5%. Although not characterized as such, this appears to be an argument that the Roberts disclosure is non-enabling,¹ but we are not convinced that one of ordinary skill in the art, given Roberts' general teachings and examples employing 42.5% solubilizer, would not know how to prepare and use a composition having 50% water.
2. With regard to the recitation of 10 to 25.0 percent of a propellant in Roberts claim 30, McLaughlin appears to be contending (again, his contentions are not clearly stated) that the Roberts application does not satisfy the description or enablement requirements of the first paragraph of 35 USC 112. These contentions are not answered in the Roberts brief.

¹ We note that the 50% limitation is described at page 21, line 9 of the Roberts application.

Formerly, Roberts' disclosure of 10 to 79% propellant at page 20, lines 20 to 24 of his application would have been sufficient to support the claimed range, since it included at least one species therewithin. *Den Beste v. Martin*, 252 F.2d 302, 116 USPQ 584 (CCPA 1958). However, in the recent decision of *Squires v. Corbett*, 560 F.2d 424, 194 USPQ 513 (CCPA 1977), the Court has held that a party must have support for the full scope of his claim.

[3] In the present case we note that Roberts discloses that the propellant may be from 10 to 79% of the product, "preferably 40 to 79% thereof and more preferably 40 to 60%" (application p. 20, lines 20 to 24); the 25% upper limit of the claimed range is not specifically disclosed. Nevertheless, applying the test enunciated in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), we are convinced that one of ordinary skill in the art, given Roberts' disclosure, would consider that use of the 10 to 25% range would be a part of his invention (see 191 USPQ at 98). Accordingly, the description requirement of 35 USC 112 is satisfied.

[4] Likewise, we consider Roberts' application to be enabling with regard to the 10 to 25% range of propellant. The fact that 10 to 25% may not be disclosed as the preferred part of the range or that there are no examples of percentages within the lower range is not persuasive that one of ordinary skill in the art would not be able to practice the invention using compositions having a propellant content within that range.

McLaughlin's Case for Priority

McLaughlin asserts in his main brief (pp. 6 to 8) that the invention of counts 1 to 3 was conceived on January 20, 1969 and actually reduced to practice on the next day, while the invention of counts 4 to 6 was conceived on January 23, 1969 and actually reduced to practice within about two weeks. In response to McLaughlin's assertions, Roberts states the following on page 1 of his brief:

Since the junior party McLaughlin relies solely upon an alleged conception and an alleged actual reduction to practice prior to the earliest date asserted on behalf of Roberts, it becomes unnecessary for Roberts' case for priority to rely upon the evidence presented in the Roberts record.

In other words, since McLaughlin does not now allege an active exercise [sic] of reasonable diligence beginning from a time just prior to the entry of Roberts into the field and continuing on down to a later reduction to practice by McLaughlin, either actual or construc-

tive, it follows that the case for McLaughlin must stand or fall on his alleged actual reduction to practice prior to the earliest date asserted on behalf of Roberts. This greatly simplifies the further proceedings herein because it thus becomes unnecessary for Roberts to rely for priority upon any of his activities prior to his earlier filing date of January 25, 1971.

Roberts then, on page 3, "accepts the allegations of conception as set forth on pages 6 to 8 of the McLaughlin Brief for purposes of this interference only."

[5] On page 5 of his reply brief, McLaughlin states that "there is also ample and adequate evidence with respect to diligence of McLaughlin from a time prior to Roberts et al. entry into the field (date of conception of May 27, 1970) until his date of reduction to practise [sic] (June 2, 1970)." However, since we find no reference whatsoever to the question of diligence in McLaughlin's main brief, we will give no consideration to his assertions of diligence. If in fact McLaughlin desired to raise the issue of diligence, it was incumbent upon him to do so in his main brief, not only in view of the requirement of 37 CFR 1.254 that "The brief for the junior party shall present a full, fair statement of the questions involved, * * *", but also as a matter of fundamental fairness. The use of such new material in a reply brief "transgresses against the canons of fair forensics." *Von Brimer v. Whirlpool Corp.* 536 F.2d 838, 190 USPQ 528, 534 (9th Cir. 1976), quoting *Frederick v. U.S.*, 163 F.2d 536, 549 (9th Cir.), cert. den. 332 U.S. 775 (1947).

Accordingly, the issue to be decided is whether McLaughlin actually reduced the subject matter of the counts to practice prior to Roberts' earliest alleged date, May 27, 1970. We will treat the two groups of counts separately.

1. Counts 1 to 3

The first formulation allegedly prepared by McLaughlin for use in the process of counts 1 to 3 is described in McLaughlin Exhibit 2 (MX-2), a copy of a page from McLaughlin's notebook containing an entry dated January 21, 1969. According to the entry, McLaughlin prepared a 40% soap solution "(80 tallow, 20 coco)" and packed it in a pump dispenser. When actuated "the product [sic] dispensed a white frosty foam."

[6] McLaughlin relies for corroboration of the preparation of this solution upon the testimony of Richard Berger, a principal and shareholder in CNPD, who signed the entry as "Read and Understood" on

"1/21/69." However it appears from Berger's testimony that he did not witness the preparation of the solution or its packing into a dispenser; rather, he testified that McLaughlin "told me that the composition was a composition containing a soap solution which was to be dispensed from a pump-type dispenser as a foam." (McLaughlin record pp. 25, 26 (MR-25, 26)). Accordingly, since the composition of the solution was merely hearsay as to Berger, based upon what the inventor told him, we do not regard his testimony as effective corroboration. McLaughlin in his reply brief (pp. 4 and 5) cites *Berry v. Webb*, 412 F.2d 261, 162 USPQ 170 (CCPA 1969) and *Grasselli v. Dewing*, 534 F.2d 306, 189 USPQ 637 (CCPA 1976) in support of his position that Berger's testimony is sufficient, but in our view neither of those cases is applicable here. *Berry v. Webb* is clearly distinguishable, for in the passage quoted by McLaughlin the Court notes that "Berry's laboratory partner, Simmons, testified to having observed the experimental work being performed" (emphasis added), whereas in the present case Berger did not so testify. The *Grasselli* case is more nearly analogous, but in that case the Court, in accepting the witness' dated signature as corroboration, noted that the witness' desk was next to that of the inventor, and that "numerous other related experiments were conducted in her presence and that she was able to watch them in their entirety" (189 USPQ at 640-641). The record here does not indicate that these circumstances would be applicable to Berger.

[7] The above-described lack of corroboration of the composition is, however, not fatal to proof of reduction to practice of counts 1 to 3, because, as McLaughlin correctly points out, these counts are not specific to any particular foam composition but merely recite a foam "containing said adjuvant material." Reduction to practice could, therefore, be corroborated by the testimony of witnesses who used a foam of unknown composition and observed that it had an adjuvant effect on the clothes being dried.

McLaughlin's record contains such testimony, both by Berger and by Patricia Teresa McLaughlin, the patentee's wife. Berger, for example, testified at MR-26:

7. Mr. McLaughlin demonstrated the composition in the pump dispenser to me on January 21, 1969 or within a day or two of that date at a laundromat which I recall to be around West 55th or West 56th Street in Manhattan. Mr.

McLaughlin asked a customer in the laundromat if he wanted his clothes softened with a new product. After getting the O.K., Mr. McLaughlin sprayed a foam from the pump dispenser onto the patron's damp clothes after they were put into the dryer. I noted visually that the foam retained its shape and was stable. The dryer was then turned on and it operated in the usual manner for a period of time. The dryer stopped and the clothes came out dry. Presumably, the foam composition was well distributed by the tumbling action of the dryer as we had thought it would be since the clothes, upon examination, appeared to have been softened.

8. The product formulated by Mr. McLaughlin on or about January 21, 1969 was also used in my home, by myself and by my wife, Bette, now divorced. I knew that it was also used by Mr. McLaughlin and his wife, Patricia, in their home. During the use in my home I was able to observe its softening action on all of the clothing in several loads of clothing which were dried in my home dryer. I was also able to observe that the foam produced by the pump was stable and form sustaining for a period of time after it was dispensed by the pump from its container.

Similarly, according to Mrs. McLaughlin (MR-31):

4. In the latter part of January 1969, my husband gave me a product to try which was in a bottle with a finger-operated pump type dispenser. He said that this contained material which would act as a fabric softener. I dispensed this material from the pump onto a load of wet clothes in the dryer. The material had a foamy consistency and stayed in shape after it was sprayed. I turned on the dryer and let it run through its cycle. After the dryer stopped, I removed the clothes and found [sic: found] that there was a softening action. I also saw my husband test this product himself. This occurred while we were still living in Ridgefield, New Jersey.

The testimony of both of these witnesses that the clothes were softened establishes that the foam contained an adjuvant, i.e., a softening agent, even though the witnesses were unaware of the specific composition of the foam that was applied to the clothes. They indicate, in addition, that the foam was well distributed, stable, and generally

had the other properties recited in counts 1 to 3.²

Accordingly, we find that the subject matter of counts 1 to 3 was actually reduced to practice by McLaughlin within a few days of January 21, 1969.

2. Counts 4 to 6

The evidence relied upon by McLaughlin to establish reduction to practice of counts 4 to 6 is analogous to that for counts 1 to 3. Thus, he refers to a notebook entry in MX-3, dated February 10, 1969 and signed "Read and Understood by" Berger on that date. The entry states that the following composition was "prepared and packed": Arquad 2HT, 5.00%; citric acid, 0.25%; propellant (Freon 12), 10.00%; water, balance to 100%.

The described composition would fall within the ranges specified in counts 4 to 6, but in our view its preparation is not properly corroborated. The only purported corroboration is found in Berger's affidavit at MR-27:

11. To my knowledge, Mr. McLaughlin immediately after January 23, 1969 began to work in the direction of making an aerosol version of the foam dryer product using the Arquad 2 HT fabric softener. On February 10, 1969, I was shown and witnessed Mr. McLaughlin's notebook page 3 (McLaughlin Exhibit 3) in which the composition packed in aerosol cans is disclosed. I understood the concept of the product and the function of the various active components of the composition used.

All that this testimony establishes is that Berger witnessed the notebook, but, as in the case of the composition allegedly prepared on January 21, 1969, there is no indication that Berger had any first-hand knowledge of its contents.

[8] Since the making of a composition falling within the counts 4 to 6 is not established by McLaughlin's record, the subsequent use of that composition cannot serve as proof of actual reduction to practice, for, unlike counts 1 to 3, counts 4 to 6 specify particular ranges for the various components of the foam. Thus, even if someone using the foam from an aerosol can given him or her by McLaughlin testified (as did Mrs. McLaughlin at MR-32) that the

clothing was softened thereby, the user could not determine whether the foam contained "from about 1.0 to 30.0 percent" of the softening agent as required by these counts.

We therefore find that McLaughlin has failed to prove prior reduction to practice of the subject matter of counts 4 to 6.

Abandonment, Suppression or Concealment

With respect to any subject matter which we may find was actually reduced to practice by McLaughlin, Roberts contends that there was abandonment, suppression, or concealment within the meaning of 35 USC 102(g). Although there is no assertion that McLaughlin was spurred into activity by another's entry into the field, Roberts takes the position that the delay of approximately two and one-half years between McLaughlin's reduction to practice and application filing dates was, *prima facie*, unreasonably long, citing *Peeler v. Miller*, 535 F.2d 647, 190 USPQ 117 (CCPA 1976).

[9] We note that in the *Peeler* case the period of delay was four years rather than the two and one-half years involved in the present case, and that the assignee of the party charged with the delay was, unlike the assignee of McLaughlin, a major corporation. We consider that these two factors alone are sufficient to avoid the charge of *prima facie* unreasonableness, and there is moreover some evidence that McLaughlin was continuing work on the invention subsequent to his actual reduction to practice.

We accordingly do not find that McLaughlin abandoned, suppressed, or concealed the subject matter of counts 1 to 3.

Award of Priority

Priority of invention of the subject matter of counts 1 to 3 is hereby awarded to James Hugh McLaughlin, the junior party; and priority of invention of the subject matter of counts 4 to 6 is hereby awarded to Karl H. Roberts, Marvin Liebowitz and Henry P. Furgal, the senior party.

² No witness testified specifically that the foam was surface adherent "for at least about thirty seconds," as recited in count 1. However, Roberts has not raised this issue, and it would appear that a foam would have to be surface adherent for at least thirty seconds in order to retain its shape and be stable.

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